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T-651 P08/17 U-447

Applic. No. 10/033,127

Amdt. dated January 28, 2005

Reply to Office action of October 28, 2004

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-5, 7-10, and 12-14 are now in the application.

~~Claims 13 and 14 have been added. Support for claim 13 can be~~

found in claim 1 and on page 31, lines 14-16 of the specification. Support for claim 14 can be found in claim 1 and on page 19, lines 13-17 of the specification. No new matter has been added.

In item 2 on page 2 of the above-noted Office action, claims 1-4, 7-10, and 12 have been rejected as being obvious over Jeschke et al. (U.S. Patent No. 4,089,264) (hereinafter "Jeschke") in view of Dini (U.S. Patent No. 3,964,386) and Wood (U.S. Patent No. 1,419,189) under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

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Claims 1, 10, 12, 13, and 14 call for, *inter alia*:

at least one metering element operatively engaging with a roller,...a plurality of glazing rollers disposed downline from the metering element along a peripheral line of the roller, each of the glazing rollers being in rolling contact

exclusively with the roller.

The Wood reference discloses a continuous ink distribution system having two composition rolls (32 and 33). The roll (32) is exclusively engaged with a cylinder (15) and the roll (33) is exclusively engaged with a cylinder (20). The Wood reference discloses that the composition roller (16) is engaged with two rolls at the same time, namely the fountain roll (13) and the roll (15). Since the composition roller (16) of Wood is not in rolling contact exclusively with one roll, the composition roller (16) of Wood cannot be compared to the glazing rollers of the instant application. Therefore, only the two composition rolls (32 and 33) of Wood can be compared to the glazing rollers of the present invention.

The question arises as to which roller of Jeschke a person of ordinary skill in the art would assign the composition rolls (32 and 33) of Wood if a person of ordinary skill in the art

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were to combine the teachings of Jeschke and Wood as in the above given rejection.

The Figure of the drawing in Wood shows that the composition rolls (32 and 33) are not assigned to the fountain roll (13) with which the blade (12) is engaged. A person of ordinary skill in the art would have to follow this teaching when combining Jeschke and Wood. A person of ordinary skill in the art would assign the composition rolls (32 and 33) of Wood to the roller (4) of Jeschke. This is the case because the ductor roller (2) of Jeschke corresponds to the fountain roll (13) of Wood, the roller (3) of Jeschke corresponds to the roll (16) of Wood, and the roller (4) of Jeschke corresponds to the cylinder (15) of Wood. Accordingly, a person of ordinary skill in the art would avoid assigning the composition rolls (32 and 33) of Wood to the ductor cylinder (2) of Jeschke, which has the ductor knife (6) assigned to it. Therefore, combining the teaching of Wood and Jeschke would lead to the ductor knife (6) of Jeschke and the composition rolls (32 and 33) of Wood being assigned to different rollers.

This is contrary to the invention of the instant application as claimed in claims 1, 10, 12, 13, and 14, in which the ink-metering device and the glazing roller are assigned to one and

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the same roller. This can be seen in Fig. 1 of the instant application (see reference numerals 7, 12, 14, 15, and 16).

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

Based on the above given arguments, the references do not show or suggest at least one metering element operatively engaging with a roller, a plurality of glazing rollers disposed downline from the metering element along a peripheral line of the roller, each of the glazing rollers being in rolling contact exclusively with the roller as recited in claims 1, 10, 12, 13, and 14 of the instant application.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Moreover, based on the above given arguments, it can be seen that Wood teaches away from the combination as suggested by the Examiner.

Furthermore, A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to

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the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the

invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998);

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In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

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Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

Since claim 1 is believed to be allowable, dependent claims 2-4 and 7-9 are believed to be allowable as well

Even though claim 14 is believed to be allowable, the following further remarks pertain to claim 14. Claim 14 recites a zone-less inking unit and that the metering unit produces an ink pattern that is even over a print width of the roller. Jeschke leads a person of ordinary skill in the art away from such a feature because the inking unit in Jeschke has ink zones (column 1, lines 5-8) and consequently, the inking pattern of Jeschke is uneven (Fig. 2).

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1, 10, 12, 13, or 14. Claims 1, 10, 12, 13, and 14 are, therefore, believed to be patentable over the art and since all of the dependent claims

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are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-5, 7-10, and 12-14 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

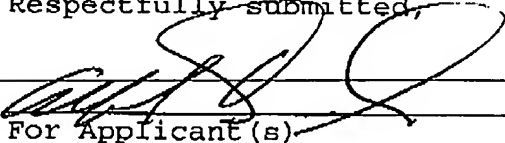
The fee for 2 additional independent claims in the amount of \$400.00 is enclosed herewith.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &
Greenberg P.A., No. 12-1099.

Respectfully submitted,



For Applicant(s)

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January 28, 2005

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